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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/047,042	10/22/2001	Roger Biel	CL/V-31641A	8043

1095 7590 06/20/2003

THOMAS HOXIE
NOVARTIS, CORPORATE INTELLECTUAL PROPERTY
ONE HEALTH PLAZA 430/2
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EXAMINER

CHAPMAN JR, JOHN E

ART UNIT	PAPER NUMBER
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2856

10

DATE MAILED: 06/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n No.

10/047,042

Applicant(s)

BIEL ET AL.

Examiner

John E Chapman

Art Unit

2856

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-10 and 12-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 10,13-19 and 24 is/are allowed.
- 6) ☒ Claim(s) 1,4,7,9 and 20 is/are rejected.
- 7) ☒ Claim(s) 3,5,6,8,12,21-23,25 and 26 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 3, 12, 21-23 and 25-26 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Note that claims 3, 12, 21-23 and 25-26 depend upon a cancelled claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form.
3. Claims 1, 4, 7, 9 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bui.

Bui discloses a method of measuring the thickness of an optical lens wherein a liquid 50 is placed on the specimen 60 and the specimen is exposed to an ultrasonic field.

Regarding claim 1, delay line 30 comprises a sonotrode. Accordingly, the only difference between the claimed invention and the prior art consists in placing an ophthalmic lens in a holding container filled with a test fluid. Regarding an ophthalmic lens, it would have been obvious to use the device of Bui to measure the thickness of any type of optical lens. Regarding a holding container, it is well known in the art to immerse a specimen in a container filled with a test fluid in order to ensure liquid coupling. Accordingly, merely to select an ophthalmic lens and place it in a holding container would have been obvious to one having ordinary skill in the art. The intended

use of the apparatus to destroy defective lenses is not given any weight, since there is no structure recited which is specific to the intended use.

Regarding claims 4 and 7, the choice of a particular size and shape is generally recognized as being within the level of ordinary skill in the art. See *In re Rose*, 105 USPQ 237 (CCPA 1955).

Regarding claim 9, it would have been an obvious design expedient to provide a sealing sleeve in order to prevent spilling.

Regarding claim 20, it would have been obvious to use the device of Bui to measure the thickness of any type of optical lens, including contact lenses.

4. Claims 5, 6 and 8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

5. Claims 10, 13-19 and 24 are allowed.

6. Applicant's arguments filed May 6, 2003 have been fully considered but they are not persuasive. Applicant argues that the device of Bui is not directed to inspecting ophthalmic lenses for defects. Inspecting for defects, however, is an intended use, and there is no structure recited which is specific to the intended use. Furthermore, Bui is directed to measuring the thickness of an optical lens, and therefore would detect a defective lens having an abnormal thickness.


Applicant further argues that Bui does not disclose or suggest using ultrasonic waves to destroy defective lenses. Such argument is likewise directed to an intended use of the device, and there is no structure recited in the device claims which is specific to the intended use.

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mr. Chapman whose telephone number is (703) 305-4920.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0956.


JOHN E. CHAPMAN
PRIMARY EXAMINER